



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,482	11/01/2001	Charles W. Moorman	CWMM-25,915	1383

31782 7590 01/23/2003

CHAUZA & HANDLEY, L.L.P.
PO BOX 140036
IRVING, TX 75014

[REDACTED] EXAMINER

HAYES, BRET C

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3644

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/001,482	MOORMAN, CHARLES W.
	Examiner	Art Unit
	Bret C Hayes	3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 21 November 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 6 – 10, 12, 13 and 17 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Regarding claim 6, lines 6 and 7, “into which...tube rotatably secured,” is unclear.
4. Claim 12 recites the limitation "the forearm" in line 9. There is insufficient antecedent basis for this limitation in the claim.
5. Regarding claim 17, it is unclear how an attachment member extending between telescopically arranged inner and outer tube sections can “prevent said inner and outer tube sections from telescopically moving in sliding relation until said tube sections are pulled fully apart.” (*Examiner's emphasis added.*)
6. Claim 19 recites the limitation "the forearm" in line 9. There is insufficient antecedent basis for this limitation in the claim.
7. Regarding claims 7 – 10, 13, 18 and 20, any claim dependent upon a claim rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is also rejected.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 – 7 and 11 –13 are rejected under 35 U.S.C. 102(b) as being anticipated by Galbraith.

10. Regarding claim 1, Galbraith discloses a portable arm support containing a saddle 13, fastening straps 14, a support tube 15 having first and second ends, the first end being pivotally mounted to the saddle 13, col. 2, lines 9 – 13, a pocket member 19 having a cavity for receiving the second end 18 of the support tube 15, and a portion of the saddle 13 defines a steady rest which engages directly against an object to provide support for such object (in this case, the object would be a user's arm).

11. Regarding claim 2, Galbraith further discloses a retaining member 30.

12. Regarding claims 3 and 11, Galbraith further discloses the support tube 15 being telescopically extensible, col. 2, lines 9 – 11, and including an attachment member 23.

13. Regarding claim 4, Galbraith further discloses at least one latch means 23.

14. Regarding claim 5, Galbraith further discloses the pocket member 19 being secured to a waist belt of the user, the cavity facing upward, and including a belt fastener strap, i.e., Fig. 1.

15. Regarding claim 6, Galbraith further discloses the saddle 13 having first and a smaller second saddle members 26, 27 rigidly attached to each other and member 27 having a swivel aperture, i.e., Fig. 3, and swivel pin 30.

16. Regarding claims 7, 12 and 13, Galbraith further discloses fastening straps **14** secured to the opposite end of the saddle **13** to secure the arm of a user.

17. Further regarding claims 12 and 13, Galbraith discloses the claimed invention except for the saddle members being formed of leather. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use leather or any other desired material known in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galbraith, as applied to claims 1 – 7 and 11 – 13 above, in view of US Patent No. 5,410,835 to Vetter.

21. Regarding claims 8 and 14, Galbraith discloses the claimed invention except for disclosing a metal retaining clip.

22. Vetter teaches a retaining clip 26 in the same field of endeavor for the purpose of holding struts 12, 20 together when not needing to be separated.

23. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Galbraith to include such clip in order to keep the saddle 13 and tube 15 releasably securable to each other.

24. Claims 9, 10, 15 – 17, 19 and 20 are rejected under 35 U.S.C. § 103 as being unpatentable over Galbraith.

25. Regarding claims 9 and 15, Galbraith discloses the claimed invention except for the specific shapes of the first and second saddles. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the first and second saddles to any desired shape, since there is no invention in merely changing the shape or form of an article without changing its function except in a design patent. *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23.

26. Regarding claims 10, 16, 19 and 20, Galbraith discloses the claimed invention except for a swivel pin specifically. It would have been an obvious matter of design choice to use a swivel pin, since Applicant has not disclosed that the swivel pin solves any stated problem or is for any particular purpose and it appears that the invention performs equally well with the lugs 28 and

bolts **29** as disclosed by Galbraith and the equivalence of these to is well known within the swiveling art.

27. Claims 17 and 18 are rejected under 35 U.S.C. § 103 as being unpatentable over Galbraith in view of US Patent Nos. 5,775,021 to Weiss or in view of 3,632,087 to Phillips.

28. Regarding claims 17, 18 and 20, in view of pp 22 above concerning claim 16, Galbraith discloses the claimed invention, including inner **16** and outer **17** tube sections telescopically engaged to each other, except for an attachment member comprising flexible line which is attached to opposite ends of the inner **16** and outer **17** tube sections, such that the inner **16** tube section cannot be fully removed from within the outer **17** tube section.

29. Weiss teaches an attachment member **16** comprising flexible line which is attached to opposite ends of collapsible tubing sections **14** and can be tensioned, such that the sections **14** cannot be fully removed from within each other, col. 4, lines 57 – 65, in the firearm art for the purpose of collapsibly connecting cleaning rod segments.

30. Phillips teaches an attachment member **84** comprising flexible line, set forth at col. 3, line 72, which is attached to opposite ends of two telescopically engageable tubular members **54, 56**, such that the inner **54** tube section cannot be fully removed from the outer **56** tube section in the telescopically engageable tubular member art for the purpose of limiting the amount of extension available telescopically between two members to a point where the two members cannot be separated from one another.

31. It would have been obvious to modify Galbraith to include a flexible line attached to opposite ends of inner and outer tube sections, such that the inner section cannot be fully

removed from the outer section as taught by either Weiss or Phillips in order to connect two or more telescopically engageable members together.

Response to Arguments

32. Applicant's arguments filed 21 November 2002 have been fully considered but they are not persuasive.

33. In response to the Applicant's argument that Galbraith does not teach a steady rest which directly engages against an object being supported, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

34. Applicant's arguments with respect to the remaining claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

35. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 3644

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306-0553. The examiner can normally be reached Monday through Friday from 7:00 am to 4:30 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan, can be reached at (703) 306-4159. The fax number for this group is (703) 305-7687.

Charles T. Jordan
CHARLES T. JORDAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

bh

1/19/03